

## **DETAILED ACTION**

### **Status of Claims**

1. Applicants' preliminary amendments, filed 4/24/2006, amending Claims 5, 6, 8, 10, and 11, are acknowledged.
2. Applicants' Information Disclosure Statement, filed 7/20/2006, is acknowledged and has been reviewed. Non-English documents have been reviewed to the extent of the provided English abstracts or documents indicated by Applicants to be equivalent.
3. Applicants' election, with traverse, of Group I (claims 1-5), drawn to an allergen-reducing agent comprising water and a disclosed water-soluble polymer compound, is acknowledged. Applicants traverse the Restriction Requirement on the grounds that "no adequate reasons and/or examples have been provided to support a conclusion of patentable distinctness between the identified groups." Further, Applicants argue 37 C.F.R § 1.475(b) states a product and a process of use of said product will be considered to have unity of invention.

Applicants' arguments have been considered and are found to be non-persuasive. As explained in the Restriction Requirement, the technical feature common to all claims is a water soluble polymer having hydroxy or carboxy groups wherein at least a part of the hydrogen atoms of the hydroxy or carboxy groups are substituted by groups represented by formula (1). This technical feature is not special because such polymers are known in the prior art, as evidenced by Nonomura et al. (previously cited). A group drawn to a product and a group drawn to a process of use of said product will

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have unity of invention if there is a special technical feature common to both groups.

This is not so in the present case (*supra*).

Finally, Applicants argue Annex B of the Administrative Instructions Under the PCT, paragraph (c), states in part, "Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims." and Claims 6-11 depend from Claim 1.

Applicants are directed to the sentence immediately following the sentence quoted by Applicants from Annex B, above. The sentence states "By 'dependent' claim is meant a claim which contains all the features of another claim and is **in the same category of claim as that other claim** (the expression "category of claim" referring to the classification of claims according to the subject matter of the invention claimed for example, product, process, use or apparatus or means, etc.)." Emphasis added. The dependent Claims 6-11 are not in the same category as independent Claim 1.

Accordingly, the Unity (Restriction) Requirement is still deemed proper and is therefore made **FINAL**.

4. Applicants' election of species is acknowledged. Applicants' provisionally elected the allergen-reducing agent specie, Aculyn™ 22. Because Applicants did not distinctly and specifically point out the supposed errors in the species election requirement, the election of species has been treated as an election **without traverse**.

5. Claims 6-11 are presently withdrawn from further consideration by the Examiner as being drawn to nonelected groups.

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6. Claim 3 is presently withdrawn from further consideration by the Examiner as being drawn to a nonelected species.

7. Accordingly, Claims 1, 2, 4, and 5 are presently under consideration.

### ***Specification***

8. The use of the trademark "Aculyn™ 22" has been noted in this application. It should be capitalized wherever it appears or alternatively, it should be denoted with the trademark symbols, ® or ™.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

9. The disclosure is objected to because of the following informalities: Formulae 6-1 and 6-2 are presented at page 59; however, there is no reference to them in the accompanying text.

Clarification/correction is required.

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Rohm and Haas ("Aculyn™ 22 Rheology Modifier/Stabilizer", 9/2002, pages 1-13).

Rohm and Haas disclose the instantly claimed agent Aculyn™ 22 (acrylates/steareth-20 methacrylate copolymer)), in combination with water. See, for example, page 10, left column, item 1. It is noted that intended use confers no patentable weight to composition claims. *In re Hack*, 114 USPQ 161. If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

12. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Fuller et al. (U.S. Patent No. 6,395,269 B1).

Fuller et al. disclose the instantly claimed agent Aculyn™ 22, in combination with *inter alia* water and dispensed as a spray from a pump spray bottle. See column 3, lines 10-16 and 25; column 5, lines 1-4 and claims 1 and 4; and column 6, claim 20. As discussed above, the intended use confers no patentable weight to composition claims.

13. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Lukenbach et al. (U.S. Patent Application Pub. No. 2002/0035046 A1).

Lukenbach et al. disclose the instantly claimed agent Aculyn™ 22, in combination with *inter alia* water, in the form of a spray, a dry wipe, a wet wipe, or a

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sponge (i.e., impregnated in the wipes or sponge). See page 4, last four lines of paragraph 65; page 16, claims 26 and 30; and page 17, claim 49. As discussed above, the intended use confers no patentable weight to composition claims.

### ***Double Patenting***

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 1, 2, 4, and 5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1, 3, 6, and 8 of copending Application No. 10/519474. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both drawn to an allergen-reducing/inactivating agent, wherein said agent is a polymer having some or all of the hydrogens of the polymer hydroxy groups are substituted with a group

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represented by formula (1) disclosed by each application. Formula (1) of instant Claim 1 fully encompasses formula (1) of the conflicting application. The polymers of the instant claims encompass the cellulose ether polysaccharide of the conflicting claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

16. Claims 1, 2, 4, and 5 are rejected.

17. No claims are allowed.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGG POLANSKY whose telephone number is (571)272-9070. The examiner can normally be reached on Mon-Thur 9:30 A.M. - 7:00 P.M. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregg Polansky/  
Examiner, Art Unit 1614

/Ardin Marschel/  
Supervisory Patent Examiner, Art Unit 1614